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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH B. ALBRITTON

Appeal 2008-5023¹
Application 09/995,615
Technology Center 3700

Decided²: March 13, 2009

Before TONI R. SCHEINER, DEMETRA J. MILLS, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving a claim to a
backpack. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

¹ Heard February 12, 2009

² The two-month time period for filing an appeal or commencing a
civil action, as recited in 37 C.F.R. § 1.304, begins to run from the
decided date shown on this page of the decision. The time period
does not run from the Mail Date (paper delivery) or Notification
Date (electronic delivery).

Statement of the Case

Background

The Specification teaches that a “travel and sports organizer bag, equipped with a method of air circulation is needed to effectively air dry articles without complex and expensive structures as well as being an organization and space saving tool that allows for quick and easy use” (Spec. 2, ll. 16-18).

The Claim

Claims 24-27, 32, 34, 35, and 37-55 are on appeal. Claims 24, 34, 35, 38, 39, 41, 43, 44, and 46 are representative and read as follows:

24. A backpack, comprising of:
a back wall;
a hook connected to a top side of said back wall, said hook capable of hanging said back wall to an object, external to said backpack;
a plurality of compartments on a front surface of said back wall, the plurality of compartments including a front portion comprised of netted material accommodating a circulation of air within said compartments, said compartments accommodating a plurality of objects;
a pair of shoulder straps disposed a predetermined distance from each other along the longitudinal side of the back surface of said back wall to accommodate a carrying of said backpack by the shoulders and the back of a user; and
wherein said backpack is secured by a fastening unit after said backpack is folded to a closed position.

34. The backpack of claim 24, further comprising at least one strap securing an object to said backpack.

35. A backpack, comprising:
a back wall;

a left wall and right wall extending from at least a portion of said back wall;

a bottom portion attached to a bottom of said back wall and said bottom portion connecting between a bottom of said right wall and said left wall;

a first wall extending from said bottom portion and assisting in holding a sufficient portion of said left and right walls together forming a bottom compartment.

38. The backpack [of claim 35, further comprising a first unit connected to a top side of said back wall, said first unit capable of hanging said back wall in the single plane to an external object]

further comprising a strap accommodating the hanging of garments along a length of said back wall.

39. A backpack, comprising:

a back member having a top, bottom and two sides;
curved side members affixed to a portion of each of said two sides of said back member;

a bottom member connected to said bottom of said back member and a bottom of each of said curved side members, said bottom member extending from a front side of said back member;

a zipper positioned on said top of said back member, a portion of each side of said back member on said curved side members and said bottom member for selectively connecting and disconnecting said top and sides of said back member to said curved side members and said bottom member; and wherein said back wall folds to form a front panel of a backpack configuration, when fastened shut, a plurality of compartments formed on a front side of said back member at spaced apart locations, said compartments being within an internal volume when said zipper connects said top and sides of said back member to said curved side member, and said bottom member, said back member forming a single plane when in an opened position to

accommodate an access and view of objects within said plurality of compartments; and

backpack straps positioned on a back side of said back member of said backpack.

41. The backpack of claim 27, with said back wall being folded by the top portion of said back wall being folded only frontally downwards towards the front portion of said bottom panel accommodating the fastening of one end of said back wall to the other end when said back wall is folded, and accommodating said first and second side walls extending from the bottom portion of said back wall being fastened to the sides of the top portion of said back wall when said back wall is folded, with the downward direction being parallel with the longitudinal direction of said shoulder straps along the longitudinal side of the back surface of said back wall, and with a zipper fastening and closing said backwall with said bottom panel not being at a lower portion of the back surface of said backwall having said shoulder straps.

43. The backpack of claim 38, with said back wall folding to close said bag by folding the top portion of said back wall to the front edge of a bottom portion of said back wall to couple with said bottom portion formed from a bottom of said backwall, said left wall and said right wall extending from the bottom portion of said back wall and upwards from said bottom of said backwall forming a bottom of said backpack.

44. The backpack of [claim 39 further comprising a hook connected to said back member for hanging said backpack when said backpack is unzipped]

with said back member selectively connecting and disconnecting said back member to said curved side members and the front of said bottom member by folding said back member frontally downwards toward the bottom member to fasten and close said backpack and unfastening

said backpack to unfold said back member upwards to a hanging position.

46. A backpack, comprising:
- a back wall including a top portion and lower portion;
 - a left wall and right wall extending along said lower portion of a left side and a right side of said back wall, respectively;
 - a bottom member formed from a bottom of said back wall and connecting a bottom of said right wall to said left wall;
 - a first wall extending from said bottom member and assisting in holding at least a portion of said left and right walls together to form a chamber;
 - a plurality of compartments on a front surface of said back wall, said plurality of compartments comprising a front portion comprising of at least a partially see-through material accommodating a circulation of air within said compartments, said compartments accommodating a plurality of objects, said plurality of compartments being disposed on a single substantially flat plane accommodating full accessibility and a view of the objects within said plurality of compartments when in an open position, said back wall folding to close said backpack, said compartments disposed from a top portion of the front surface of said back wall to a bottom member of said back wall covering a substantial portion of the front portion of said backwall, said backwall being separate from the other walls;
 - a zipper positioned on said top portion of said back wall and around said side walls and first wall accommodating selectively connecting and disconnecting said top and sides of said back wall to said side walls and said first wall, said back wall folds to form a front panel of a backpack configuration, when fastened shut, said compartments being within an internal volume when said zipper connects said top and sides of said back wall to said side walls and said first wall; and

a pair of straps disposed on the back surface of said lower portion of said back wall to accommodate a transport of said backpack on a back of a user through both shoulders of a user for each strap, said pair of straps disposed a predetermined distance from each other along the longitudinal side of the back surface of said lower portion of said back wall to accommodate a carrying of said backpack by the shoulders and the back of a user, said back portion of said lower portion of said back wall having only said pair of straps and being substantially flat when said backpack is closed, said backwall, sidewalls, first wall and bottom member being made of a flexible material.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Davis	US Patent 2,626,689	Jan. 27, 1953
Briggs	US Patent 4,901,897	Feb. 20, 1990
Bomes	US Patent 5,054,589	Oct. 8, 1991
Franklin	US Patent 5,575,362	Nov. 19, 1996
Wulf	US Patent 5,749,503	May 12, 1998
Yu	US Patent 6,129,254	Oct. 10, 2000
Fournier	US Patent 6,193,034 B1	Feb 27, 2001
Kilduff	US Patent 6,386,414 B1	May 14, 2002
Tong	US Patent 6,334,519 B1	Jun. 1, 2002

The issues

- A. The Examiner rejected claims 41, 43 and 45-53 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 3-4).
- B. The Examiner rejected claims 41 and 45-53 under 35 U.S.C. § 112, second paragraph as indefinite (Ans. 4).
- C. The Examiner rejected claims 35 and 37 under 35 U.S.C. § 102(a) as anticipated by Fournier (Ans. 5).
- D. The Examiner rejected claims 39, 40, and 44 under 35 U.S.C. § 102(b) as anticipated by Tong (Ans. 4).
- E. The Examiner rejected claims 24-26 and 32 under 35 U.S.C. § 103(a) as obvious over Tong and Fournier (Ans. 4).
- F. The Examiner rejected claim 34 under 35 U.S.C. § 103(a) as obvious over Tong and Briggs (Ans. 5).
- G. The Examiner rejected claim 38 under 35 U.S.C. § 103(a) as obvious over Tong, Fournier, and Davis (Ans. 5).
- H. The Examiner rejected claims 24-27, 32, 35, 37, and 39-45 under 35 U.S.C. § 103(a) as obvious over Franklin, Wulf, and Bomes (Ans. 5-6).
- I. The Examiner rejected claims 24-27, 32, 35, 37, 39-48, 54, and 55 under 35 U.S.C. § 103(a) as obvious over Franklin, Wulf, Yu, and Fournier (Ans. 6).
- A. 35 U.S.C. § 112, first paragraph, written description, claims 41, 43, and 45-53*

The Examiner finds that “[r]egarding claim 41, the disclosure does not teach the back wall being folded **only** frontally forward” (Ans. 3). The

Examiner finds that “[r]egarding claim 46, the disclosure shows that the back wall are always connected to the two sidewalls and the bottom walls, thus, the recitation that the back wall being separate from the other walls is incorrect” (Ans. 3). The Examiner finds that “in claim 43, the claim recites that the back wall folding the top portion of the back wall to the front edge of **a bottom portion of the back wall**. Since [parent] claim 35 defines the bottom member as a separate member the back wall would be attach to the bottom portion, not the **bottom portion of the back wall**” (Ans. 3-4).

Appellant contends, for claim 41, that “figure 8 which has the bag in the open position with the back wall 780 and figure 10 shows the bag of figure 8 being closed. The closed zipping action of zipper 738 in the closed position shows how the bag can be closed frontally forward” (App. Br. 12-13). Appellant contends, for claim 46, that “the closing in figure 10 shows that the back wall can be separate from other walls such as side walls 724. Furthermore, paragraphs 59-61 describe the separate description for the back wall 780 and walls such as sidewall 724” (App. Br. 13).

Appellant contends, for claim 43, that “the folding action accommodates the top portion of the back wall to couple with the bottom portion of the backwall and as seen in figure 8 and 10, this is possible” (App. Br. 13).

In view of these conflicting positions, we frame the description issue before us as follows:

(1) Did the Examiner err in finding that the disclosure of the Specification and figures failed to demonstrate possession of “a backwall only folded frontally downward” in claim 41?

(2) Did the Examiner err in finding that the disclosure of the Specification and figures failed to demonstrate possession of a “back wall folding . . . the top portion of said back wall to the front edge of a bottom portion of said back wall” in claim 43?

(3) Did the Examiner err in finding that the disclosure of the Specification and figures failed to demonstrate possession of “a backwall being separate from the other walls” in claim 46?

Findings of Fact (FF)

1. Claim 41 was amended³ with the word “only” being inserted to state “said back wall being folded by the top portion of said back wall being folded only frontally downwards towards the front portion of said bottom panel” (Claim 41).

2. Claim 35 states that the backpack comprises “a bottom portion attached to a bottom of said back wall and said bottom portion connecting between a bottom of said right wall and said left wall” (Claim 35).

3. Claim 43, which indirectly depends from claim 35, states that the “back wall folding to close said bag by folding the top portion of said back wall to the front edge of a bottom portion of said back wall to couple with said bottom portion formed from a bottom of said backwall” (Claim 43).

4. Claim 46 states that there is a back wall where “said backwall being separate from the other walls” (Claim 46).

5. The Specification teaches that the “side walls 724 form angles with the extended portion 786 of the bottom back wall 782 of the backpack

³ Appellant’s Response of November 22, 2004.

710 accommodating a backpack that closes all sides which then stop any loose items that get out of the compartments 770” (Spec. 18, l. 20 to 19, l. 1).

6. The Specification teaches a bag of figure 8 as reproduced below:

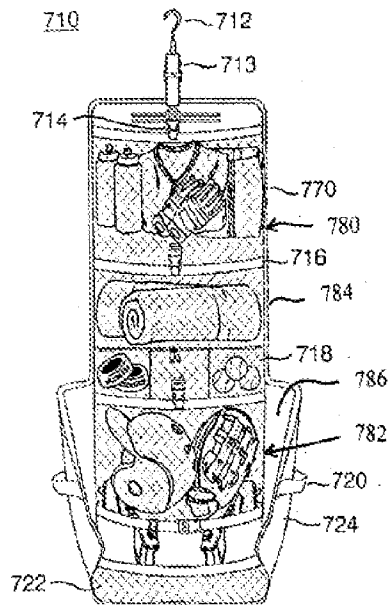


Fig. 8

“Fig. 8 is another embodiment of a backpack in an open position” (Spec. 4, l. 19).

7. The Specification teaches a bag of figure 10 as reproduced below.

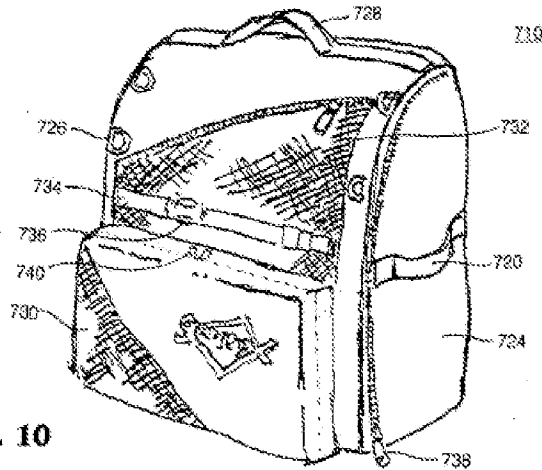


Fig. 10

“Fig. 10 is the backpack of Fig. 8 in a closed position” (Spec. 5, l. 1).

8. The Specification teaches that the “backpack 710 can be closed from an open position as seen in Fig. 8 to the closed position as seen in Fig. 10 with a zipper 738 or other fastening means” (Spec. 18, ll. 8-10).

9. The Specification teaches that the backpack can function where “the top portion 160 can be folded to meet with the bottom portion 170 of the object holder 10 to connect the two sides using the adjustment strap 146” (Spec. 11, ll. 7-8).

Principles of Law

It is the Examiner's “initial burden [to] present [] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976).

To satisfy the written description requirement, the inventor must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v.*

Mahurkar, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of the *invention* by describing the *invention*, with all its claimed limitations.” *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

“Although [the inventor] does not have to describe exactly the subject matter claimed . . . the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989).

Analysis

Claim 41

There is no doubt that the recitation of “said back wall being folded only frontally downwards” was not disclosed *ipsis verbis* in the Specification or originally filed claims (FF 1, 6-8). Of course, *ipsis verbis* support is not required. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996).

The Specification teaches that “backpack 710 can be closed from an open position as seen in Fig. 8 to the closed position as seen in Fig. 10 with a zipper 738 or other fastening means” (Spec. 18, ll. 8-10; FF 8). There is no doubt that a skilled artisan would have recognized that a backpack with a zipper on the front as depicted in figures 8 and 10 (FF 6, 7), would functionally close “only” frontally downwards as required by claim 41.

Claim 43

In the context of claim 43, the Examiner finds that since claim 35 states “a bottom portion attached to a bottom of said back wall” as a separate member, the back wall of claim 43 would “attach to the bottom portion, not the **bottom portion of the back wall**” (Ans. 4). However the Specification

contemplates two sides connected to the bottom portion of a back wall which attach by folding the top portion down, since the Specification teaches that the backpack can function where “the top portion 160 can be folded to meet with the bottom portion 170 of the object holder 10 to connect the two sides using the adjustment strap 146” (Spec. 11, ll. 7-8; FF 9).

Additionally, figures 8 and 10 disclose an example where the backwall is attached to a bottom member which is a bottom portion of, and part of, the back wall itself (FF 6, 7).

Claim 46

The Examiner states that the “disclosure shows that the back wall [is] always connected to the two sidewalls and the bottom walls” (Ans. 3).

While Appellant states that “the closing in figure 10 shows that the back wall can be separate from other walls such as side walls 724” (App. Br. 13), figure 10 shows that the side wall is not separate from, but is attached to, side wall 724 (FF 6, 7). Consequently, we agree with the Examiner that there is no description in the Specification of a backwall which is separate from the sidewalls as required by claim 46. *See Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007) (“When no such description can be found in the specification, the only thing the PTO can reasonably be expected to do is to point out its nonexistence.”).

Conclusions of Law

(1) The Examiner erred in finding that the disclosure of the Specification and figures failed to demonstrate possession of “a backwall only folded frontally downward” in claim 41.

(2) The Examiner erred in finding that the disclosure of the Specification and figures failed to demonstrate possession of a “back wall folding . . . the top portion of said back wall to the front edge of a bottom portion of said back wall” in claim 43.

(3) The Examiner did not err in finding that the disclosure of the Specification and figures failed to demonstrate possession of “a backwall being separate from the other walls” in claim 46.

B. 35 U.S.C. § 112, second paragraph, indefiniteness, claims 41 and 45-53

The Examiner finds that “Regarding claim 41, ‘said back wall being folded by the top portion of said back wall being folded’ is confusing. Regarding claim 46, it is unclear how the back wall being separate from the other walls” (Ans. 4).

Appellant contends, regarding claim 41, that “the claim as [a] whole . . . states that the back wall [is] folded only frontally downwards, thereby the fold is . . . frontally downwards” (App. Br. 14). Appellant contends, regarding claim 46, that “the backwall 780 can be separate from the sidewalls 724 as seen in figures 8, 10 and related specification” (App. Br. 14).

In view of these conflicting positions, we frame the indefiniteness issue before us as follows:

Did the Examiner err in finding that claims 41 and 46 are vague and indefinite?

Principles of Law

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

In *Miyazaki*, the Board stated that

rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

Ex Parte Miyazaki, 89 USPQ2d 1207, 1211 (BPAI 2008).

Analysis

We agree with Appellant that claim 41 is readily understood by those of skill in the art, who would understand that the phrase “said back wall being folded by the top portion of said back wall being folded only frontally downwards towards the front portion of said bottom panel” describes the situation where the top of the back wall is folded forwards to meet the bottom in order to close the bag.

Regarding claim 46, the Examiner finds that “it is unclear how the back wall [is] separate from the other walls” (Ans. 4). The skilled artisan would have understood the meaning of the phrase “a backwall being separate from the other walls” in claim 46 as it literally reads. The Examiner

does not indicate how this phrase is amenable to multiple different constructions or is indefinite.

Conclusion of Law

The Examiner erred in finding that claims 41 and 46 are vague and indefinite.

C. 35 U.S.C. § 102(a) over Fournier, claims 35 and 37

The Examiner finds that

Fournier teaches a back wall 2, left and right wall, a bottom portion attached to a bottom of the back wall 1, a first wall 2 extending from the bottom portion and assisting in holding a sufficient portion of left and right walls together, a plurality of compartments on a front surface of the back wall comprising of netted material, and at least one strap 5 as claimed. The term backpack does not impart any structure over the bag in Fournier. Kilduff . . . teaches the two straps can be carried on the shoulder as a backpack.

(Ans. 5).

Appellant contends that “by using Kilduff, there cannot be a 35 U.S.C. § 102 rejection” (App. Br. 16). Appellant contends that “[n]either of the . . . scenarios presented in MPEP §2131.01 [regarding the use of two references in an anticipation rejection] are pertinent in the present rejection as the Examiner is attempting to use two references to anticipate limitations in the present invention” (App. Br. 17).

Appellant specifically contends that “it is not clear that the actual straps of Fournier can accommodate a carrying on the back of the user” (App. Br. 17). Appellant contends regarding Kilduff that “the Examiner failed to provide a rationale for needing inherency” (App. Br. 18).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Did the Examiner err in finding that Fournier teaches a bag which comprises the elements of claim 35 and would have inherently been capable of functioning as a backpack?

Findings of Fact

10. Fournier teaches a bag as shown in figure 4 reproduced below:

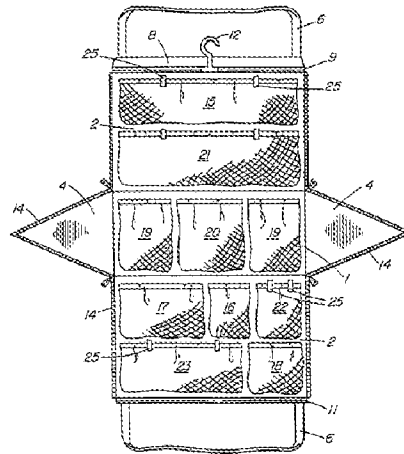


FIG. 4

“FIG. 4 is a front view of the sports bag in the planar configuration”
(Fournier, col. 4, ll. 29-30).

11. Fournier teaches that the bag has “side walls (2) and end walls (4) hinged upwardly from the base (1) . . . and connected together by zippers (14)” (Fournier, col. 4, ll. 49-51).

12. Fournier shows, in figure 4 in FF 10 above, a back wall (2), with left and right walls (4) which extend from the back wall, a bottom portion which is attached to the back wall and connects the back, right and left walls and a front wall which extends from the bottom portion to form a bottom compartment (Fournier, fig. 4; FF 10).

13. Fournier teaches the bag in a closed configuration as reproduced below:

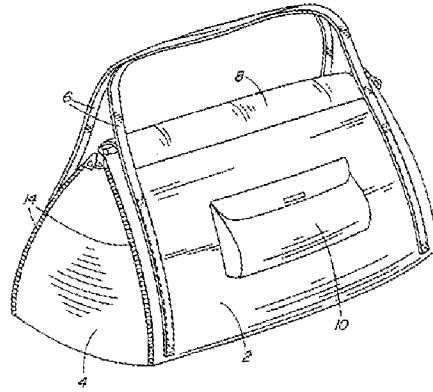


FIG. 2

“FIG. 2 is a perspective view of a sports bag in the closed configuration (Fournier, col. 4, ll. 23-24).

14. Fournier teaches “a plurality of pockets disposed- on interior surfaces of the base and side walls, the pockets comprising a moisture- and air- permeable material which permits air to circulate therethrough” (Fournier, col. 3, ll. 18-21).

15. Fournier teaches that the compartments can be disposed on a single plane and view of the compartments when the backpack is in the open position (*see* Fournier, fig. 4; FF 10).

16. Fournier teaches that the “pockets are generally transparent” (Fournier, col. 3, ll. 55-56).

17. Fournier teaches handles (6) which “facilitate both hand-held transport of the bag and over-the-shoulder carrying” (Fournier, col. 4, ll. 53-55).

18. Kilduff teaches “[s]traps **108** may be gripped in one hand and carried horizontally, as is conventional . . . straps **108** are also preferably

designed to allow bag **10** to be carried in as a backpack” (Kilduff, col. 4, ll. 29-32).

Principles of Law

“A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed.Cir.1994). *See In re Omeprazole Patent Litigation*, 483 F.3d 1364, 1371 (Fed. Cir. 2007).

(“Anticipation requires disclosure of each and every claim limitation in a single prior art reference, either explicitly or inherently.”)

“Our predecessor court's decision in *Samour* supports the use of secondary references to show that a primary § 102(b) reference was in fact enabled.” *In re Elsner*, 381 F.3d 1125, 1129 (Fed. Cir. 2004).

“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). “Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products.” *Id.* at 1255.

Analysis

Fournier teaches a bag with a back wall, left and right walls extending from the back wall, a bottom portion which connects to the back wall and to the bottoms of the right and left walls (FF 10-12). Fournier teaches a plurality of compartments which have see-through material and permit circulation of air disposed on a single plane (FF 10, 13-16). Fournier teaches that the back wall can fold to close the bag (FF 13). Fournier teaches a strap which permits shoulder transport (FF 17-18).

Fournier satisfies all of the structural limitations of claim 35 (FF 10-18). The only element not taught by Fournier is the intended use recitation that the strap should “accommodate shoulder and back transport of [the] backpack” (Claim 35). However, “[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

Appellant does not argue that any limitations are absent in Fournier (App. Br. 15-18). Appellant confines the argument to Kilduff, arguing that Kilduff is improperly included in the rejection and that Kilduff does not teach the elements of the invention (App. Br. 16- 17). While the Examiner might have more clearly demonstrated that Kilduff is an evidentiary reference for the inherency of straps to function as backpack straps by putting “as evidenced by Kilduff” in the statement of the rejection, the Examiner clearly did not rely upon any structural disclosure of Kilduff in the

rejection (Ans. 5). The Examiner relied upon Kilduff to teach that “two straps can be carried on the shoulder as a backpack” (Ans. 5).

The use of additional references to evidence that a reference is enabled is permitted. *See In re Samour*, 571 F.2d 559, 563 (CCPA 1978) (“Additional references cited in a rejection under 35 U.S.C. § 102(b) are not relied on for a suggestion or incentive to combine teachings to meet claim limitations (as in a rejection under 35 U.S.C. s 103), but, rather, to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public.”).

Conclusion of Law

The Examiner did not err in finding that Fournier teaches a bag which comprises the elements of claim 35 and would have inherently been capable of functioning as a backpack.

D. 35 U.S.C. § 102(b) over Tong, claims 39, 40, and 44

The Examiner finds that “Tong teaches a backside member, a bottom member and straps. Kilduff . . . teaches the two straps can be carried on the shoulder as a backpack” (Ans. 4).

Appellant contends, as above, that the Examiner’s citation of Kilduff means that “[s]ince there is not a single reference, a 35USC102 would be improper” (App. Br. 19). Appellant also contends that “the present invention includes a zipper while Tong needs multiple zippers as seen in figure 4. A single zipper cannot fully open close the side walls on the left and right side” (App. Br. 19).

Appellant contends regarding claim 44 that Tong does not teach “connection or disconnection of the back member to the curved side

members as claimed. For example, such connection would not be possible with the handbag of Tong” (App. Br. 19).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Did the Examiner err in finding that Tong teaches a bag which comprises the elements of claims 39 and 44 and would have inherently been capable of functioning as a backpack?

Findings of Fact

19. Tong teaches a bag of figure 3 as reproduced below:

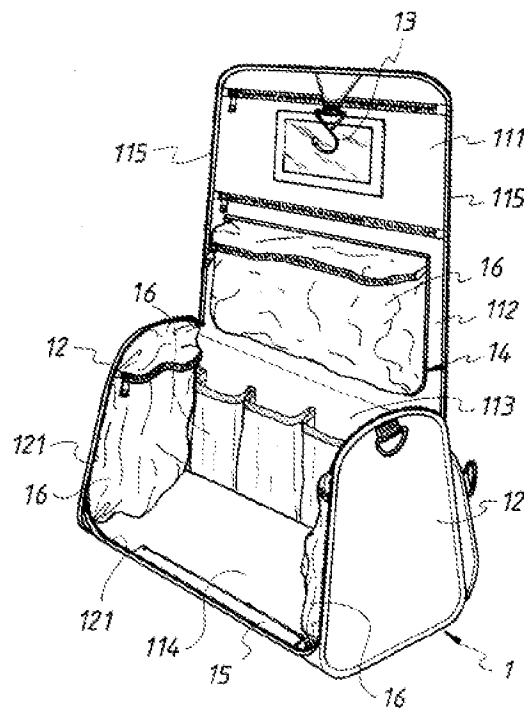


FIG. 3

“FIG. 3 is a three dimensional illustration of the [bag] in an erected open condition” (Tong, col. 1, ll. 52-53).

20. Tong teaches a bag with top, bottom and two sides which are “composed of a four-fold piece **11** and two sidings **12** which are to be coupled to both sides of the fourth fold **114**” (Tong, col. 1, ll. 65-67). Tong discloses “curved” sidings **12** (*see* Tong, Fig. 3; FF 17).

21. Tong teaches “a container pouch **116** which is made of web texture or tape” (Tong, col. 2, ll. 15-16).

22. Tong teaches that each of the “fold pieces **111**, **112** and **113** each has a zipper **115** on the outer rim, on the extension of the two sidings **21** circumferentially to the tail side of the fourth fold **114** are provided a symmetrical zipper **121**, so that be interactive drawing of zipper **115** with zipper **121**, the first three fold pieces **11**[**1**, **112**, **113** may form a pouch” (Tong, col. 2, ll. 1-6).

23. Tong also teaches that the bag may comprise straps (*see* Tong, fig. 2).

24. Tong discloses that the back member may be selectively connected and disconnected to the curved side members and front of the bottom member (*see* Tong, fig. 3; FF 17).

Principles of Law

Claim terms are interpreted using the broadest reasonable interpretation in light of the Specification. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”). *Also see In re Morris*, 127 F.3d 1048, 1054-56 (Fed. Cir. 1997). (“Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their

interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.”)

The transitional term “comprising” is “inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1327, (Fed. Cir. 1999).

Analysis

Claim 39

Tong teaches a bag with a back member having a top, bottom and two curved side members attached to the back member and a bottom member (FF 19-20). Tong teaches that the bag comprises a zipper on the back member to selectively connect the back member to the curved side members (FF 21, 22 and 24). Tong teaches that the bag may comprise straps (FF 23).

We are not persuaded by Appellant’s argument that “Tong needs multiple zippers as seen in figure 4. A single zipper cannot fully open [or] close the side walls on the left and right side” (App. Br. 19). Claim 39 does not require that a single zipper is used to open and close both sides, only that at least one zipper is present which is position on the back member and connects the side members and back members (*see* Claim 39). The claim preamble is drawn to “[a] backpack, comprising” where “comprising” is “inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” *Georgia-Pacific*, 195 F.3d at 1327. The presence of a second zipper is not excluded by claim 39.

Claim 44

We are not persuaded by Appellant's argument that "looking at Tong . . . there is no such connection or disconnection of the back member to the curved side members as claimed" (App. Br. 19). Tong teaches a bag which selectively connects the back and side members using a zipper (FF 19-23). Tong also clearly folds the back member down to the bottom member to fasten (FF 19).

Conclusion of Law

The Examiner did not err in finding that Tong teaches a bag which comprises the elements of claims 39 and 44 and would have inherently been capable of functioning as a backpack.

E. 35 U.S.C. § 103(a) over Tong and Fournier, claims 24-26 and 32

The Examiner finds that

Tong teaches a hook unit 13, back wall, left and right walls 12, a bottom portion 16 attached to a bottom of the back wall 1, a plurality of compartments on a front surface of the back wall, and at least one strap as claimed. Tong meets all claimed limitations except for the netted compartments. Fournier teaches that it is known in the art to provide netted compartments. It would have been obvious to one of ordinary skill in the art to provide netted compartments in Tong as taught by Fournier to provide venting for the contents.

(Ans. 4.)

Appellant contends that "in Tong the two straps are not along the longitudinal side of the back surface of the backwall [as required by claim 24] but along the lateral side" (App. Br. 20). Appellant also contends that "Kilduff is improperly introduced by the Examiner as he does not cite in this

rejection and does not provide any motivation or suggestion to combine with Tong and Fournier (App. Br. 20-21).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Did the Examiner err in finding that the combination of Tong, Fournier, and Kilduff render claim 24 obvious in light of the evidence of secondary considerations of industry praise and commercial success?

Findings of Fact

25. Tong discloses a pair of straps which are disposed a predetermined distance from each other laterally on the back wall, as shown in figure 2, reproduced below:

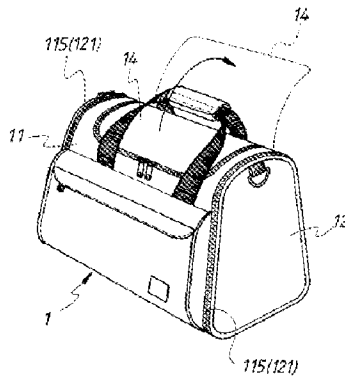


FIG. 2

“FIG. 2 is an illustration of the [bag] in a three-dimensional setting” (Tong, col. 1, ll. 50-51).

26. Fournier discloses a pair of straps which are disposed a predetermined distance from each other laterally on the back wall, as shown in figure 2 (*see* FF 13).

27. The Albritton 2007 Declaration includes a copy of an article detailing how the instant invention won the United Inventors Association grand prize (Albritton Declaration). The article states that “Gearmax looks like a typical backpack when it’s closed, but unzipped it’s an extremely well-organized sports or travel equipment bag that can be conveniently hung and used as a ‘virtual’ locker with a built-in ventilation system” (Albritton Declaration).

28. The Albritton 2007 Declaration shows that luggage market grew 10% in 2003 and 24% in 2004, while the market for the Gearmax bag grew 384% in 2003 and 94% in 2004 (Albritton Declaration).

29. The Albritton 2004 Declaration includes a letter from Diana Hubbard, a buyer for a fitness facility, which states that “I purchased the Gearmax packs because of its unique features. The backpack’s unique design that allows it to be unzipped to a hanging locker is especially attractive in a busy locker room . . . We had to reorder half way through our planned three month promotion . . . This great demand for the product provided the best referral promotion we have had in our twenty-year history” (Albritton 2004 Declaration).

30. The Albritton 2004 Declaration includes a letter from Jeff Appling, which states that “the Gearmax pack . . . was selected over other bags on the market because of its unique features. The bag design allows access to loaded contents without having to empty the bag and can be hung by the attached hook placing it up off the floor in clear view” (Albritton 2004 Declaration).

31. The Albritton 2004 Declaration includes a licensing agreement which states that the license is for “Sports Equipment Bag, Organizer and ventilator, U.S. Patent Application Serial No. 09/995,615” (Albritton 2004 Declaration, License Agreement C at 3).

Principles of Law

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1740 (2007).

“When the PTO shows prima facie obviousness, the burden then shifts to the applicant[s] to rebut.” *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

In *Graham*, the Supreme Court stated that “secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Graham*, 383 U.S. at 17-18.

Objective evidence of secondary considerations must be considered in making an obviousness decision. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). Any initial obviousness determination is reconsidered anew in view of the proffered evidence of nonobviousness. *See In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976).

Licenses taken under the patent in suit may constitute evidence of nonobviousness; however, only little weight can be attributed to such evidence if the patentee does not demonstrate “a nexus between the merits of the invention and the licenses of record.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983).

Commercial success “is relevant in the obviousness context only if there is proof that the sales were a direct result of the unique characteristics of the claimed invention—as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.” *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996).

“[I]nformation solely on numbers of units sold is insufficient to establish commercial success.” *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991). The evidence must also demonstrate commercial success in the relevant market. *See In re Huang*, 100 F.3d at 140 (a very weak showing of commercial success, if any, is shown where there is no indication of whether the number of units sold represents a substantial quantity in the relevant market); *see also Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1150-51 (Fed. Cir. 1983) (“There was no evidence of market share, of growth in market share, of replacing earlier units sold by others or of dollar amounts, and no evidence of a nexus between sales and the merits

of the invention. Under such circumstances, consideration of the totality of the evidence, including that relating to commercial success, does not require a holding that the invention would have been nonobvious at the time it was made to one skilled in the art.”).

“Ready recognition of the merits of a new product does not establish obviousness. Commercial success and copying are tributes to ingenuity, not evidence of legal obviousness. This rule is no less worthy when the new product narrowly fits into a field already well explored-like the fishing lure art-than when a transcendent scientific breakthrough is launched.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997).
Analysis

Prima Facie Case of Obviousness

Tong teaches a bag with top, bottom and two sides which are “composed of a four-fold piece **11** and two sidings **12** which are to be coupled to both sides of the fourth fold **114**” (Tong, col. 1, ll. 65-67; FF 22). Tong teaches that the bag has a hook and a plurality of compartments (FF 21). Tong teaches straps placed laterally on the bag (FF 23, 25).

Fournier teaches mesh compartments (FF 14) and laterally placed shoulder straps (FF 26). Kilduff teaches backpack straps (FF 18).

Applying the *KSR* standard of obviousness to the findings of fact, we agree with the Examiner that it would have been *prima facie* obvious to modify the bag of Tong to utilize mesh compartments as taught by Fournier and backpack straps as taught by Kilduff. Such a combination is merely a “predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. 398, ___, 127 S. Ct. at 1740.

We are not persuaded by Appellant's argument that "in Tong the two straps are not along the longitudinal side of the back surface of the backwall but along the lateral side" (App. Br. 20). While this limitation prevents Tong from anticipating the claims, Kilduff teaches backpack straps on the longitudinal side of the back surface, and the combination of Tong, Fournier, and Kilduff satisfy the requirements of claim 24.

Secondary Considerations

However, the determination that the claims are *prima facie* obvious does not end our inquiry where Appellants have submitted objective evidence of a secondary consideration of nonobviousness. *See Graham*, 383 U.S. at 17-18.

Secondary considerations include industry praise and commercial success, which requires a nexus between the commercial success and the claimed invention and may be evidenced by commercial success in the relevant market, licensing agreements, and increases in market share. *See Kansas Jack, Inc. v. Kuhn*, 719 F.2d at 1150-51; *Stratoflex*, 713 F.2d at 1539; *In re Huang*, 100 F.3d at 140.

Appellant has provided specific evidence of industry praise, both in winning the grand prize of the United Inventors Association and in letters from purchasers (FF 27, 29, 30). Both the prize award and the letters provide evidence of a nexus between the merits of the claimed invention and the commercial success of the product, linking the features of a backpack, open ventilated compartments and a hook (FF 27, 29, 30).

Appellant has also provided evidence of commercial success in the relevant market and increased market share relative to the increase in luggage sales generally (FF 28).

Lastly, Appellant has provided specific licensing agreements, one of which is drawn to the product of the instant U.S. Patent Application (FF 31).

We think this is a close case, as “commercial success [is a] tribute[] to ingenuity, not evidence of legal obviousness. This rule is no less worthy when the new product narrowly fits into a field already well explored . . . than when a transcendent scientific breakthrough is launched.” *Arkie Lures*, 119 F.3d at 957. Balancing the reasonable *prima facie* case of obviousness with the secondary considerations of industry praise and commercial success, however, we conclude that the claimed invention is nonobvious.

Conclusion of Law

The Examiner erred in finding that the combination of Tong, Fournier, and Kilduff render claim 24 obvious in light of the evidence of secondary considerations of industry praise and commercial success.

F. 35 U.S.C. § 103(a) rejection over Tong and Briggs, claim 34

The Examiner finds that “Tong meets all claimed limitations except for the straps. Briggs teaches that it is known in the art to provide straps 18 in a folding bag” (Ans. 5). We agree with the Examiner that Tong and Briggs satisfy the requirements necessary to demonstrate *prima facie* obviousness. As discussed above, we find that Appellant has demonstrated secondary considerations of nonobviousness including industry praise and commercial success.

Balancing the reasonable *prima facie* case of obviousness with the secondary considerations of industry praise and commercial success, we conclude that claim 34 is nonobvious over Tong and Briggs.

G. 35 U.S.C. § 103(a) rejection over Tong, Fournier, and Davis, claim 38

The Examiner finds that “[i]t would have been obvious to one of ordinary skill in the art to provide straps in either Fournier or Tong as taught by Davis to provide a place for hanging garments” (Ans. 5). We agree with the Examiner that Tong, Fournier, and Davis satisfy the requirements necessary to demonstrate *prima facie* obviousness. As discussed above, we find that Appellant has demonstrated secondary considerations of nonobviousness including industry praise and commercial success.

Balancing the reasonable *prima facie* case of obviousness with the secondary considerations of industry praise and commercial success, we conclude that claim 38 is nonobvious over Tong, Fournier and Davis.

H. 35 U.S.C. § 103(a) rejection over Franklin, Wulf, and Bomes, claims 24-27, 32, 35, 37, and 39-45

The Examiner finds that “Franklin meets all claimed limitations except for the straps. Wulf teaches that it is known in the art to provide back straps. . . . Bomes teaches that it is known in the art to provide mesh compartments 60” (Ans. 6). We agree with the Examiner that Franklin, Wulf, and Bomes satisfy the requirements necessary to demonstrate *prima facie* obviousness. As discussed above, we find that Appellant has demonstrated secondary considerations of nonobviousness including industry praise and commercial success.

Balancing the reasonable *prima facie* case of obviousness with the secondary considerations of industry praise and commercial success, we conclude that the claims are nonobvious over Franklin, Wulf, and Bomes.

I. 35 U.S.C. § 103(a) rejection over Franklin, Wulf, Yu, and Fournier, claims 24-27, 32, 35, 37, 39-48, 54, and 55

The Examiner finds that “[i]t would have been obvious to one of ordinary skill in the art to provide a plurality of netted compartments covering the front portion of the back wall to accommodate a plurality of objects” (Ans. 6). We agree with the Examiner that Franklin, Wulf, Yu, and Fournier satisfy the requirements necessary to demonstrate *prima facie* obviousness. As discussed above, we find that Appellant has demonstrated secondary considerations of nonobviousness including industry praise and commercial success.

Balancing the reasonable *prima facie* case of obviousness with the secondary considerations of industry praise and commercial success, we conclude that the claims are nonobvious over Franklin, Wulf, Yu, and Fournier.

SUMMARY

In summary, we reverse the rejection of claims 41, 43, and 45 under 35 U.S.C. § 112, first paragraph written description. We affirm the rejection of claim 46 under 35 U.S.C. § 112, first paragraph. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 47-53 as these claims were not argued separately.

We reverse the rejection of claims 41 and 45-53 under 35 U.S.C. § 112, second paragraph.

We affirm the rejection of claims 35 and 37 under 35 U.S.C. § 102(a) as anticipated by Fournier. We affirm the rejection of claims 39, 40, and 44 under 35 U.S.C. § 102(b) as anticipated by Tong.

We reverse the rejections of claims 24-26 and 32 under 35 U.S.C. § 103(a) as obvious over Tong and Fournier. We reverse the rejection of claim 34 under 35 U.S.C. § 103(a) as obvious over Tong and Briggs. We reverse the rejection of claim 38 under 35 U.S.C. § 103(a) as obvious over Tong, Fournier, and Davis. We reverse the rejection of claims 24-27, 32, 35, 37, and 39-45 under 35 U.S.C. § 103(a) as obvious over Franklin, Wulf, and Bomes. We reverse the rejection of claims 24-27, 32, 35, 37, 39-48, 54, and 55 under 35 U.S.C. § 103(a) as obvious over Franklin, Wulf, Yu, and Fournier.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED-IN-PART

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